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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Lauri Piikivi

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PERMAN & GREEN
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EXAMINER

TESLOVICH, TAMARA

ART UNIT

PAPER NUMBER

2137

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/928,026

Applicant(s)

PIIKIVI, LAURI

Examiner

Tamara Teslovich

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This action is in response to the Applicant's Remarks and Amendments filed March 1, 2006.

Claims 1-16 are pending and herein considered.

Response to Arguments

Applicant's arguments filed March 1, 2006 have been fully considered but they are not persuasive.

In response to the Applicant's arguments on pages 2 and 3 concerning Dominguez's alleged failure to disclose the 'selection means connected to receive a control message signal from the second party said signal including a plurality of selectable security protocols' of independent claims 1 and 14, the Examiner respectfully disagrees. The Applicant asserts that the mere assessment of whether a capability is present or not is distinct from selection, however in the situation at hand, according to paragraph 76, not only is an assessment made as to the security protocol, but rather the system is configured to respond accordingly dependent upon that protocol. In fact, the merchant plug-in is programmed to communicate with the client in order to determine the necessary steps once it is determined what protocol will be relied upon. It is clear from this, that the system contains the necessary intelligence to deal accordingly with the different systems and allow for the selection of a variety of protocols.

In response to the Applicant's allegations that the application at hand predates that of the prior art, the Examiner would like to note that although the Dominguez parent filing date is that of April 24, 2001 that parent receives the filing date of its provisional application filed on April 24, 2000, 4 months before the Applicant's filing of his invention.

In response to the Applicant's arguments on pages 3 and 4 concerning Williams' alleged failure to disclose the 'selection means connected to receive a control message signal from the second party said signal including a plurality of selectable security protocols' of independent claims 1 and 14, the Examiner respectfully disagrees. Lines 52-56 of column 16 clearly disclose that PayWindow determines the payment protocol preferences according to the wishes of the consumer and the available protocols put forth by the system. It is clear from the abovesited sections as well as additional sections through the prior art reference, that the PayWindow system contains the necessary programming to interface the wishes of the user and the availabilities of the system, including the necessary security protocols.

In view of the arguments previous, Examiner respectfully disagrees with the Applicant's argument that Dominguez fails to disclose claims 1-16 in their entirety, and maintains the previously presented 35 U.S.C. 102(e) rejections repeated below. The Examiner also respectfully disagrees with the Applicant's argument that Williams fails to disclose claims 1-2, 5, 8-10, 11 and 13 in their entirety, and maintains the previously presented 35 U.S.C. 102(e) rejections repeated below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-16 remain rejected under 35 U.S.C. 102(e) as being anticipated by Dominguez et al. (US Patent Application Publication 2002/0194138).

As per **Claim 1**, Dominguez teaches a device comprising connecting means for establishing a communication link with a second party and selection means connected to receive a control message signal from said second party said signal including a plurality of selectable security protocols and in response thereto to select one of the plurality of security protocols whereby information transferred subsequently between the device and second party is protected using the selected security protocol (pars 69-70, 76, 82).

As per **Claim 2**, Dominguez teaches selection means further comprises analysis means which analyze the data contained in said control message signal and in response thereto selects the security protocol (pars 76, 82).

As per **Claim 3**, Dominguez teaches calculating means for generating an EMV cryptogram from data held in at least one data field of the control message signal (pars 68-69, 219).

As per **Claim 4**, Dominguez teaches cryptogram transmitting means provided to transmit the EMV cryptogram from the mobile station to initiate secure transfer of information from the device (pars 68-69, 219).

As per **Claim 5**, Dominguez teaches means to provide a start payment signal from the device to the second party which thereby initiates the control message signal from the second party (par 33).

As per **Claim 6**, Dominguez teaches means for communicating, when said selected security protocol is the SET standard, with a modified SET wallet server which is adapted to receive an EMV cryptogram generated by the device and thereafter to communicate with a SET payment gateway via the second party according to the SET standard (par 45). Note: The Examiner has relied on the above-cited paragraph to demonstrate Dominguez's use of secure wallets within his invention and the modes of communication associated with them. Although Dominguez fails to specifically mention the term "SET" within his disclosure, it should be brought to the Applicant's attention that the technical specification for security financial transactions on the internet, today known as SET, was introduced by VISA in conjunction with MasterCard in 1996, over 4 years before the filing of the prior art at hand.

As per **Claim 7**, Dominguez teaches means for communicating, when said selected security protocol is the EMV standard, with the second party directly via an EMV cryptogram generated via the device (par 68-69, 219).

As per **Claim 8**, Dominguez teaches 1 wherein the control message signal comprises a series of data fields each containing data indicating a predetermined parameter for the transaction (pars 72-76).

As per **Claim 9**, Dominguez teaches wherein the control signal includes a data field which indicates whether the device can communicate directly with the second party or with the second party via a modified SET wallet (par 45).

As per **Claim 10**, Dominguez teaches internet browsing circuitry which enables a user of the device to access and browse the internet via the device (pars 14, 33, 35, 36, 38).

As per **Claim 11**, Dominguez teaches connecting means enables a connection to be established between said device and a second party via the Internet (pars 14, 33, 35, 36, 38).

As per **Claim 12**, Dominguez teaches wherein said device comprises a mobile station (par 38).

As per **Claim 13**, Dominguez teaches wherein said second party comprises a merchant server associated with a merchant offering an item to be purchased (par 3).

As per **Claim 14**, Dominguez teaches a device comprising connecting means for establishing a communication link with a second party, selection means for selecting one of a plurality of security protocols and being connected to communicate said

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selection to said second party (pars 69-70, 76, 82), calculating means for generating an EMV cryptogram for transmittal from said device (par 68-69, 219), whereby information transferred subsequently between the device and second party is protected using the selected security protocol (pars 69-70, 76, 82).

As per **Claim 15**, Dominguez teaches a device comprising connecting means for establishing a communication link with a second party, selection means for selecting a SET security protocol and being connected to communicate said selection to said second party, and calculating means for generating an EMV cryptogram for transmittal from said devices whereby information transferred subsequently between the device and second party is protected using the SET security protocol (pars 45, 69-70, 76, 82).

Note: The Examiner has relied on the above-cited paragraphs to demonstrate Dominguez's use of secure wallets within his invention and the modes of communication associated with them. Although Dominguez fails to specifically mention the term "SET" within his disclosure, it should be brought to the Applicant's attention that the technical specification for security financial transactions on the internet, today known as SET, was introduced by VISA in conjunction with MasterCard in 1996, over 4 years before the filing of the prior art at hand.

As per **Claim 16**, Dominguez teaches a device comprising connecting means for establishing a communication link with a second part, selection means for selecting a EMV security protocol and being connected to communicate said selection to said second party (pars 69-70, 76, 82), whereby information transferred subsequently

between the device and second party is protected using the EMV security protocol (pars 68-69, 219).

Claims 1-2, 5, 8-10, 11, and 13 remain rejected under 35 U.S.C. 102(e) as being anticipated by Williams et al. (US Patent No. 5,963,924).

As per **Claim 1**, Williams teaches a device comprising connecting means for establishing a communication link with a second party and selection means connected to receive a control message signal from said second party said signal including a plurality of selectable security protocols and in response thereto to select one of the plurality of security protocols, whereby information transferred subsequently between the device and second party is protected using the selected security protocol (col.14 lines 8-24; col.14 line 64 thru col.15 line21; col.16 lines 53-56; col.21 line 35 thru col.22 line 8).

As per **Claim 2**, Williams teaches analysis means which analyze the data contained in said control message signal and in response thereto selects the security protocol (col.13 lines 51-54; col.15 lines 54-56; col.16 lines 53-56).

As per **Claim 5**, Williams teaches means to provide a start payment signal from the device to the second party which thereby initiates the control message signal from the second party (col.15 lines 53-55).

As per **Claim 8**, Williams teaches wherein the control message signal comprises a series of data fields each containing data indicating a predetermined parameter for the transaction (col.15 lines 53-55).

As per **Claim 9**, Williams teaches wherein the control signal includes a data field which indicates whether the device can communicate directly with the second party or with the second party via a modified SET wallet (col.14 lines 8-24).

As per **Claim 10**, Williams teaches internet browsing circuitry which enables a user of the device to access and browse the internet via the device (abstract, col.10 line 38 thru col.11 line 12; col.9 lines 27-67).

As per **Claim 11**, Williams teaches wherein said connecting means enables a connection to be established between said device and a second party via the Internet (abstract, col.10 line 38 thru col.11 line 12; col.9 lines 27-67).

As per **Claim 13**, Williams teaches wherein said second party comprises a merchant server associated with a merchant offering an item to be purchased (abstract, col.10 line 38 thru col.11 line 12).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara Teslovich whose telephone number is (571) 272-4241. The examiner can normally be reached on Mon-Fri 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

May 29, 2006

TT


EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER